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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,806	03/17/2004	James Marggraff	020824-004610US	5601
41066 7590 09/22/2009 MURABITO, HAO & BARNES, LLP TWO NORTH MARKET STREET, THIRD FLOOR SAN JOSE, CA 95113				
EXAMINER				
GISHENOCK, NIKOLAI A				
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3715				
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09/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/803,806

**Applicant(s)**

MARGGRAFF ET AL.

**Examiner**

NIKOLAI A. GISHNOCK

**Art Unit**

3715

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-44, 46-48, 50-60 and 62-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-44, 46-48, 50-60 and 62-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/31/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In response to Applicant's Request for Continued Examination and response filed 8/14/2009, claims 1-37, 45, 49, & 61 are cancelled. Claims 38-44, 46-48, 50-60, & 62-75 are pending.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 38-44, 46-48, 50-60, & 62-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Blume (US 6,915,103 B2), hereinafter referred to as Blume.

3. Blume discloses a computing device and computer readable media for implementing a method for providing instructional response, comprising: an input device operable to read a first and a second plurality of substantially invisible codes disposed on a surface (user identifies the book and page number, then taps the stylus, 3:32-44), wherein a the print elements are disposed substantially invisible codes (3:57-4:9), and wherein said first and said second plurality of substantially invisible codes provide location information of said first and said second print elements respectively (substantially invisible machine-readable coordinate grid, 3:57-4:9), wherein said receiving is responsive to a user selection of said first print element via an input device (3:44-56); a processor for processing substantially invisible codes (4:46-5:5), wherein said processing comprises: determining a first position associated with said first print element

responsive to a user selection thereof (3:18-30); and in response to said determining said first position, mapping said first position to a location in memory that a first instructional response associated with said first location is stored (index to database of information, 3:32-44), wherein said first instructional response is an instruction from said computing device for use by a user of said computing device (such as, "turn the page when you hear the BEEP, 1:29-35); and an output device for outputting said first instructional response (audio speaker, 4:46-5:5), wherein said input device, said processor and said output device reside in a same housing (4:46-5:5) [Claims 57, 69, & 73-75].

4. Blume discloses a stylus having an optical detector for detecting said first and said second plurality of substantially invisible codes printed on said surface (detector, 3:18-30), a memory unit comprising code for audio outputs corresponding to the said first and said second print elements element (ROM or RAM, 5:64-6:6) [Claims 40, 52, & 64], and a processor coupled to the optical detector [Claims 40 & 64] (microprocessor, 4:46-5:5) [Claims 40, 52, & 64].

5. Blume discloses wherein the output device is an audio output device operable to output an audio instructional response associated with plurality of substantially invisible codes [Claims 41, 43, 53, 55, 65, & 67], wherein a task is audibly presented to the user by the audio output device [Claims 42, 54, & 66], and wherein the first instructional response relates to a task presented to the user [Claims 47, 59, & 71]. ("turn the page when you hear the BEEP, 1:29-35; see also tests, 7:32-54) [Claims 41-43, 47, 53-55, 59, 65-67, & 71].

6. Blume discloses wherein the computing device is a writing device (a stylus, 3:7-17) and wherein the processor, the input device, the output device, and the writing device form a housing having a pen-like appearance (3:7-17 & 4:46-5:5; the housing disclosed by Blume in Figures 1 & 2 is understood to be a single unit) [Claims 48, 60, & 72].

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 38, 39, 46, 50, 51, 56, 58, 62, 68, & 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume, in view of Kardach (US 2003/0001020 A1), hereinafter referred to as Kardach.

10. Blume teaches all the features of Claims 41, 53, 65, & 73-75, as demonstrated above. What Blume fails to teach is wherein the unstructured user input comprises a first print element is a non-keyboard [Claims 46, 58, & 70] user created [Claims 38, 50 & 62] element, created by the user on said surface [Claim 38], where the device has a writing element [Claims 39, 51, & 63], wherein said surface is a writing surface [Claims 44, 56, & 68]. However, Kardach teaches a method and apparatus for taking an electronic application program's output and printing them on a piece of paper having a preprinted pattern thereon, thereby creating a hardcopy representation. The hardcopy representation of the application includes a unique ID, which associates the application printed on the page with the preprinted pattern on the paper. Using a special pen, edits may be made to the hardcopy representation. The pen records these edits

and sends the updates to a computer system automatically. In response to the receiving the edits, the computer system updates the electronic application automatically (Abstract). A pen may be used to make edits to the hardcopy representation. The pen includes an inkwell for dispensing ink from the pen, a camera to create images of the unique pattern on the hardcopy representation as well as the ID, and a processor coupled to the camera to control the operation of the camera. When the pen draws a line across the ID icon, it reads the ID pattern and then the paper pattern, which are both part of this larger pattern. The ID icon pattern location will be associated with the printed application, while the paper pattern will be associated with a blank page function. When the pen recognizes a pen stroke between these two pattern areas, the local composer will then associate that paper pattern with the meaning assigned it via the ID pattern. During the creation of the paper application {i.e., when it was printed}, the computer will have stored paper pattern information associated with the functions to be performed {e.g., writing in this pattern area means to create an appointment} (Para. 0033-34, see also Figure 5, Item 501). The stylus taught by Blume would contain an ink writing element disposed therein, to be used in the manner taught by Kardash for editing a document electronically with a visible, written pen stroke. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have implemented the ink writing element disposed in the pen taught by Kardash, for a user to create an unstructured user input print element on the writing surface taught by Blume, in order to associate a printed piece of paper with an application in an ad-hoc fashion [Claims 38, 39, 46, 50, 51, 56, 58, 62, 68, & 70].

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 37-72 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIKOLAI A. GISHNOCK whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 11:00a-7:30p EST (8:00a-4:30p PST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/18/2009  
/N. A. G./  
Examiner, Art Unit 3715

/XUAN M. THAI/  
Supervisory Patent Examiner, Art Unit 3715